

REMARKS

Reconsideration of this application is respectfully requested in view of the following remarks.

Claims 1-6 are currently pending in the present application and subject to examination. Claims 7-13 were previously withdrawn.

In the Office Action mailed June 5, 2006, the Examiner rejected claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,801,820 to Lilly ("Lilly") in view of U.S. Patent No. 5,914,878 to Yamamoto ("Yamamoto"). The Applicants hereby traverse the rejection as follows.

Applicants' invention as set forth in claim 1 is directed to an order in/out processing system including, in part, ordering means used by an order receiver to make an order to an associate on the basis of order data and business plan data acquiring means used by said order receiver to acquire business plan data from the associate.

This enables the order receiver to make physical distributions according to its own program and allows the orderer to make preparations for receiving the order while reducing the amount of intervening personnel and steps required to provide such notice.

Lilly teaches a computerized system for scheduling work orders including receiving in a computer work order information and data regarding resource availability and material availability.

However, the Applicants respectfully submit that Lilly does not disclose or suggest ordering means used by the order receiver to make an order to an associate on the basis of the order data.

In addition, the Examiner admits that Lilly does not disclose or suggest business plan data acquiring means used by said order receiver to acquire business plan data from the associate. The Examiner relies on Yamamoto as teaching the missing feature.

Yamamoto teaches a production system for retail goods including a raw material ordering system where daily production plan data is calculated and compared with current inventory in order to determine the necessary order size of raw materials. (See Yamamoto column 13 line 40 – column 14, lines 45 and column 19, lines 47-50). Thus, the Applicants submit that Yamamoto does not disclose or suggest business plan data acquiring means used by said order receiver to acquire business plan data from an associate. Instead, Yamamoto teaches generating production plan data for the orderer prior to placing an order.

Therefore, the Applicants submit that if Lilly and Yamamoto were combined, which is not admitted, the combination would merely teach a work order planning system which includes a raw material ordering system for determining what raw materials need to be ordered.

The Applicants submit that Lilly and Yamamoto, whether taken individually or in combination fail to disclose or teach an order in/out processing system including, at least, ordering means used by an order receiver to make an order to an associate on the basis of order data and business plan data acquiring means used by said order receiver to acquire business plan data from the associate, as claimed in claim 1.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of

obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at page 3. This is an insufficient showing of motivation.

For at least these reasons, the Applicants submit that claim 1 is allowable over the cited art. The Applicants submit that claim 4 is likewise allowable. Claims 2-3 and 5-6 each depend from allowable claims 1 and 4 and, therefore, are also allowable for at least the above noted reasons and for the additional limitations they provide.

CONCLUSION

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references.

Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, with reference to Attorney Docket No. 101173-00014.

Respectfully submitted,

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